

REMARKS

Claims 15-34 are pending in the present application before this preliminary amendment as set forth above. By the amendment, claims 15, 16, 22, 23, 25, 31 and 33 are amended, and new claims 35-38 are introduced. These amendments were not presented earlier because applicant genuinely believed that the previously presented claims were in condition for allowance. Applicant respectfully submits herewith the preliminary amendment, concurrently with an RCE request. Accordingly, these amendments should be admitted and entered.

In the June 23, 2008 Final Office Action, the Primary Examiner rejected claims 15-34 under 35 U.S.C. §103(a) as being unpatentable over Fukushima (JP 2002-020576). Applicant timely filed an Amendment October 20, 2008 responsive to the Final Office Action. However, the Amendment was considered not placing the application in condition for allowance and an Advisory Action was subsequently issued November 5, 2008.

Applicant very appreciates the Primary Examiner's careful review of the present application.

In response, as set forth above, claims 15, 16, 22, 23, 25, 31 and 33 have been amended for better form. Specifically, claims 15, 16 and 31 have been amended to replace the term "vinyl copolymer segment" with "vinyl polymer segment" for clarification. In independent claims 15, 22, 31 and 33, as amended, the vinyl polymer segment is formed from the vinyl monomers that include at least styrene and butyl acrylate. The specification does not disclose a recitation of "vinyl copolymer segment." Rather, the specification has a recitation of "vinyl polymer segment", for example, at page 3, line 8; page 4, line 3 and 12-13; paragraph bridging pages 5 to 6; and page 28, line 4.

Furthermore, new claims 35-38 have been introduced to conform claims to the embodiments of the present invention and disclosed in the specification, as originally filed. Support for new claims 35-38 may also be found in, for example, paragraph bridging pages 5 to 6 and Reference example 5

Thus, applicant asserts that no new matter is added.

Any amendments to the claims not specifically referred to herein are included for the purpose of clarification, consistence and/or grammatical correction only.

It is now believed that the application is in condition for allowance at least for the reasons set forth below and such allowance is respectfully requested.

The following remarks herein are considered to be responsive thereto.

Applicant respectfully submits that the present invention is not obvious over Fukushima. According to 35 USC 103(a), a claimed invention may be found to have been obvious "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter *as a whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." (Emphasis added.) Moreover, the Federal Circuit has ruled on numerous occasions the a holding of "obviousness" requires some motivation, suggestion or teaching within the cited reference(s) that would lead one skilled in the art to modify the cited reference(s) or as claimed by applicant. See, for example, In re Kotzab, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000), which states:

"Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See *id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp., 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996)."

The cited Fukushima reference fails to disclose, among other things, a feature recited in independent claims 15, 22, 31 and 33, namely, *"a vinyl polymer segment formed from vinyl monomers, the vinyl monomers including at least styrene and butyl acrylate."* For example, in paragraph 0072 (reference example 1), Fukushima uses butyl acrylate and acrylonitrile. In

paragraph 0075 (reference example 5), Fukushima uses styrene. However, Fukushima does not disclose or suggest the noted feature of the applicant invention.

The foregoing amendments clarify the difference between the claimed invention and Fukushima examples. In view of the foregoing amendments and the unexpected results submitted on October 20, 2008, independent claims 15, 22, 31 and 33, as amended, are not obvious over Fukushima, and are patentable over Fukushima.

Accordingly, claims 16-21, 23-30, 32, and 34-38, which depend from now allowable amended claims 15, 22, 31 and 33, respectively, are also patentable at least for this reason.

CONCLUSION

Applicant respectfully submits that the foregoing Amendment and Response place this application in condition for allowance. If the Examiner believes that there are any issues that can be resolved by a telephone conference, or that there are any informalities that can be corrected by an Examiner's amendment, please call the undersigned at 404-495-3678.

Respectfully submitted,

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